

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejection of the application are respectfully requested in view of the amendments and remarks herein, which place the application into condition for allowance.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-19 and 21-22 are currently pending. Claims 1, 3-5, 10, 13, 16, and 21-22, which are independent, are hereby amended. Support for this amendment is provided throughout the Specification as originally filed, and specifically at pages 47-53.

No new matter has been introduced by this amendment. Changes to the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. REJECTIONS UNDER 35 U.S.C. §102(e) and 103(a) HAVE BEEN OVERCOME

Claims 1-4 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent Application Publication No. 2002/0046407 to Franco (hereinafter, merely “Franco”) in view of U.S. Patent Application Publication No. 2002/0010927 to Kim (hereinafter, merely “Kim”).

Claims 5-15 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Franco in view of U.S. Patent No. 6,704,929 to Ozer et al. (hereinafter, merely “Ozer”).

Claims 18-19 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Franco.

Claims 16 and 21-22 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by Franco.

As understood by Applicants, Franco relates to a remotely programmable broadcast content recording system that is programmed through a web page to record broadcast content such as television programs.

As understood by Applicants, Ozer relates to systems and methods for providing and tracking viewing behavior of home entertainment systems.

As understood by Applicants, Kim relates to methods and apparatus for interactive digital television service networks.

Claim 1 recites, *inter alia*:

“... display control means for controlling the displaying of said advertisement-associated data received by said receiving means to display said advertisement-associated data as a function of the keyword data and said television program substantially at same time for a viewer to view said advertisement-associated data while simultaneously viewing said television program.” (Emphasis added)

Applicants respectfully submit that (1) the combination of Franco, Kim, and Ozer does not teach the above-recited feature of claim 1; (2) that the applied combination teaches away from the claimed invention; and (3) that the applied combination is improper because it lacks motivation and relies on impermissible hindsight.

The cited portions of Franco, Kim, and Ozer do not disclose or suggest, displaying the advertisement-associated data as a function of the keyword data and the television program substantially at same time for a viewer to view the advertisement-associated data while simultaneously viewing the television program, as recited in claim 1. The Office Action concedes that Franco fails to disclose displaying the advertisement-associated data and the television program substantially at same time for a viewer to view the advertisement

associated data while simultaneously viewing the television program. The Office Action instead relies on Kim for a teaching of this feature. However, Kim fails to teach or suggest that the advertisement-associated data is a function of the keyword data, as recited in claim 1.

Furthermore, Applicants respectfully submit that MPEP §2141.02 (VI) states that

“A prior art reference must be considered in its entirety, i.e., as a whole, **including portions that would lead away from the claimed invention**. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).” (Emphasis added)

Indeed, Applicants respectfully submit that Franco teaches away from displaying the advertisement-associated data and the television program at the same time, so that a user views simultaneously the advertisement-associated data and the television program. Franco teaches on page 12, paragraph [0133], that “viewers can avoid watching commercials that are not of interest,” which clearly teaches away from a viewer viewing the advertisement-associated data while simultaneously viewing the television program, as recited in claim 1.

Finally, Applicants respectfully submit that MPEP §2143.01(III) states that

“**The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination**. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)” (Emphasis added)

Applicants respectfully submit that the Office Action has failed to provide a suggestion or motivation to combine the teachings of Franco and Kim, and to further modify that combination as allegedly suggested by Ozer. Applicants respectfully submit there is no motivation anywhere in the art of record to suggest the applied combination. Since there is no motivation in the references themselves, the Office Action has relied on impermissible hindsight to create a mosaic of features from the prior art in a futile attempt to create a vague resemblance of Applicants' claimed invention.

The Office Action relied on Official Notice in order to reject claims 18-19 on page 6 and claims 6-7, 11-12, and 14-15 on page 13. Applicants respectfully traverse the Official Notice. There is no reference or teaching, much less a motivation to combine, the use of correlation information (such as keyword information or the like).

Therefore, for at least the reasons stated above, Applicants respectfully submit that claim 1 is patentable.

For reasons similar, or somewhat similar, to those described above with regard to independent claim 1, independent claims 3-5, 10, 13, 16, and 21-22 are also patentable.

III. DEPENDENT CLAIMS

The other claims are each dependent from one of the independent claims discussed above, and are therefore patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

The Office Action relied on Official Notice in order to reject claims 18-19 on page 6 and claims 6-7, 11-12, and 14-15 on page 13. Applicants respectfully traverse the Official Notice. There is no reference or teaching, much less a motivation to combine, the use of correlation information (such as keyword information or the like).

CONCLUSION

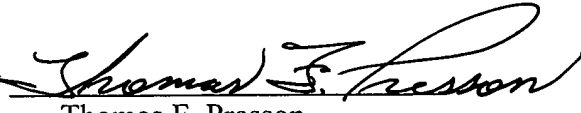
All claims are in condition for allowance. In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference(s), it is respectfully requested that the Examiner specifically indicate those portion(s) of the reference(s), providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By 
Thomas F. Presson
Reg. No. 42,442
(212) 588-0800